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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,829

08/09/2006

Volker Knop

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EXAMINER

NGUYEN, XUAN LAN T

ART UNIT

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3657

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/588,829	Applicant(s) KNOP ET AL.	
	Examiner Lan Nguyen	Art Unit 3657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-22 and 26-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/9/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of species A in the reply filed on 8/4/09 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 15-22 and 26-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- Claim 15 recites indefinite terms “can be”, “being allowed”, “so that” and “is rendered possible”. These terms do not specify definite structures or functions since they imply that some functions could happen or could not and some structures could be there or could not.
- Claim 18 recites indefinite terms “there is provision”. Is there another spring or a possibility of another spring?
- Claim 19 recites indefinite terms “threaded-nut/spindle assembly” and “integrally designed” which does not specify that it has been made and is integral with.
- Claims 26 and 28 recite indefinite terms “can be”.
- Claim 27 recites indefinite terms “a pressure build up is executed”. It is unclear if the pressure is built up or not.

Due to these indefiniteness, claims 15-22 and 26-28 are being treated as best understood.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 15 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al. (US 4014414).

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Re: claim 15, Yamamoto shows a hydraulic vehicle brake, as in the present invention, including a brake housing (22) in which a hydraulic working pressure chamber (30) is delimited by a brake piston (34), wherein the brake piston, in the applied condition, can be locked by means of a locking device 40, 42, locking thereof being allowed by a relative movement of a force-transmitting element (48, 50), wherein an energy accumulator cooperating with the brake piston is provided, which is comprised of a lockable accumulator pressure chamber (32), an accumulator piston (38) delimiting the accumulator pressure chamber, and at least one spring element (60) being supported on the accumulator piston, wherein the force-transmitting element (48, 50) can be entrained by the accumulator piston in a direction opposite to the direction of application of the brake piston and can be arrested by an electromagnetic or an electromechanical actuator (76) so that a relative movement between the force-transmitting element and the accumulator piston is rendered possible.

Re: claim 28, Yamamoto shows the inlet 74 to be connected to a master cylinder actuated manually by a brake pedal.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claims 15, 16, 19-22 and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Giers (US 2006/0220447 A1)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Re: claim 15, Giers shows a hydraulic vehicle brake, as in the present invention, including a brake housing (1) in which a hydraulic working pressure chamber (7) is delimited by a brake piston (6), wherein the brake piston (6), in the applied condition, can be locked by means of a locking device, locking thereof being allowed by a relative movement of a force-transmitting element (21), wherein an energy accumulator (10) cooperating with the brake piston (6) is provided, which is comprised of a lockable accumulator pressure chamber adjacent the inlet 8, an accumulator piston (94) delimiting the accumulator pressure chamber, and at least one spring element (90) being supported on the accumulator piston (94), wherein the force-transmitting element (21) can be entrained by the accumulator piston in a direction opposite to the direction of application of the brake piston (6) and can be arrested by an electromagnetic or an electromechanical actuator (91) so that a relative movement between the force-transmitting element (21) and the accumulator piston (11) is rendered possible.

Re: claim 16, please note the bore in piston 94 is in the form of a stepped bore.

Re: claims 19-22, Giers shows the threaded nut (15) thereof being rigidly connected to the brake piston (6), while the spindle (16) includes a first friction surface (97) cooperating, in the locked condition, with a second friction surface (98) that is arranged in a non-rotatable manner at the accumulator piston (94); wherein the force-transmitting element (21) forms a central bearing for the spindle (16); wherein the actuator is electromagnetically operated and cooperates with an armature plate (92) being in a force-transmitting connection with the force-transmitting element (21); wherein the coil (91) of the electromagnetic actuator performs the function of a sensor for detecting the position of the armature plate (92).

Re: claims 26-28, Giers shows the hydraulic accumulator pressure chamber can be closed by means of an electrically operable valve (13, 14); wherein a pressure buildup is executed both in the working pressure chamber and in the accumulator pressure chamber by means of a hydraulic pump 4 or by means of a pressure generator 31 that can be manually actuated by pedal 11.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (US 4014414).

Re: claim 19, Yamamoto further shows the spindle 42, nut 40 wherein the conical surfaces are with the spindle and the brake piston while the claim requires the conical surfaces to be with the spindle and the accumulator piston. It is considered to be a re-arranging of parts. In that the threaded spindle and nut assembly work with the conical surfaces of either the brake piston or the accumulator piston to affect the force transferring function between the two pistons resulting in a parking brake application or a release of the same parking brake. It would have been obvious and a routine for one of ordinary skill in the art to have re-arranged the spindle and nut assembly and the conical surfaces between the two pistons to affect the force transferring function between the two pistons resulting in a parking brake application or a release of the same parking brake.

Re: claims 20-22, Yamamoto shows the force transmitting element 48, 50 to be in a central location of the spindle 42, the armature 80 and the coil 76 as claimed.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 15, 19-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 15 of copending Application No. 11/792,443. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application encompass the claim of the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

13. Claims 17 and 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mohr et al. and Halasy-Wimmer et al. are cited other similar brake systems.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lan Nguyen whose telephone number is (571) 272-7121. The examiner can normally be reached on Monday through Friday, 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on (571) 272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Xuan Lan Nguyen/
Primary Examiner
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